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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,224	10/15/1999	KOJI MATSUMOTO	0020-4621P	6995

7590

03/01/2004

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EXAMINER

REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 03/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/403,224	Applicant(s) MATSUMOTO ET AL.	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-14 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9, 10, 13 & 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 02/06/04 has been entered.

Election/Restrictions

Claims 11 and 12 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention. Applicant's continued traversal of the restriction requirement based on the belief that the subject matter of claims 9 & 10 is sufficiently connected to claims 11 and 12 and no undue burden is placed on the Examiner to examine all of the claims in unison is acknowledged. However, such is not deemed to be persuasive. It is well established that just because a process claim is found allowable it does not translate to allowable product claims. Product claims made by any process, which could lead to an equivalent product, would necessitate a search that involves additional searching and concepts. Moreover, it is not just the search but also the entire prosecution.

Claim Rejections - 35 USC § 102(b) - 35 USC § 103

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a

Art Unit: 1713

whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9, 13 & 14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO 95/15995, Tatemoto et al (as applied to claims 9 & 13) or Albano et al.

WO'995 discloses processes for making molded products such as are instantly claimed, see, e.g., Claim 1, page 4, lines 10-17 and the Runs. WO'995 teaches @ page 1, lines 11 and 12 that fluoroelastomers because of excellent heat resistance and oil resistance are commonly used for O-rings, gaskets, etc. which makes the claimed O-rings readily envisaged by one having ordinary skill in the art. WO'995 specifically discloses the use of t-butyl cumyl peroxide and dicumyl peroxide (page 3, lines 9-13) and the use of 0.3 parts by weight (pbw) of the peroxide is also specifically taught (page 3, lines 17-19 and Claim 4). The use of peroxide in amounts of 0.5 and 1 pbw is exemplified in Runs 1 and 2. Therefore, one having ordinary skill in the art would have readily envisaged the use of t-butyl cumyl peroxide or dicumyl peroxide in amounts of 0.3, 0.5 and 1.0 pbw in the compositions of WO'995.

Tatemoto et al disclose elastic fluorine-containing polymers, compositions and molded articles therefrom wherein, the fluorine-containing polymers comprising bonded iodine can be cross-linked (col. 1, lines 22-45, col. 6, lines 60-66). The iodine content is preferably 0.01 to 5 wt.%(col. 1, lines 51-58). Specifically, it is taught that the fluorine-containing polymers can be used as a component of a molding material (the paragraph bridging cols. 6-7) which makes molding the material and simultaneously curing readily envisaged by one having ordinary skill in the art. Specific examples of the cross-linking agent include di-t-butylperoxide, t-butylcumylperoxide and dicumylperoxide (the paragraph bridging cols. 4-5) and the preferable use of 0.5 pbw is specifically taught (col. 5, lines 24-26). Therefore, one having ordinary skill in the art would have readily

Art Unit: 1713

envisaged the use of di-t-butylperoxide, t-butyl cumyl peroxide or dicumyl peroxide in amounts of 0.5 pbw in the compositions of Takemoto et al. The inclusion of 0.1 to 10 parts by weight of polyfunctional unsaturated compounds is also specifically disclosed(col. 5, lines 11-26).

Albano et al disclose curable compositions of fluoroelastomers containing preferably 0.01 to 2.5 wt.% of iodine(col. 1, lines 57-64, col. 4, lines 64-66). Curing with di-t-butylperoxide and dicumylperoxide is specifically disclosed(paragraph bridging cols. 4-5) and the use of 0.5 and preferably 1% by wt is specifically taught(col. 2, lines 54-56). Therefore, one having ordinary skill in the art would have readily envisaged the use of di-t-butylperoxide or dicumyl peroxide in amounts of 0.5 and 1.0 wt.% in the compositions of Albano et al. The inclusion of 0.1 to 1.0 wt.% of polyfunctional unsaturated compounds is also specifically disclosed(col. 5, lines 7-18). Use of the compositions in making gaskets and seal rings(e.g., Claim 14) makes molding and simultaneous curing readily envisioned by one having ordinary skill in the art.

The "consisting essentially of" phrase per claim 13 limits the scope of a claim to the specified ingredients/steps and to those that do not materially affect the basic and novel characteristics of a composition(Ex parte Davis, 80 USPQ 448; In re Janakirama-Rao, 317 F2d 951, 137 USPQ 893).

The compositions of WO'995, Tatemoto et al and Albano et al, prior to undergoing a secondary curing, are made by the same process as is instantly claimed. Therefore, prior to undergoing secondary curing, it is tenable to assume that the compositions of patentees meet any of the limitations of decomposition products and contribution of compression set after one curing.

It has been held that where applicants claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the Examiner has explained why the function, property or characteristics is considered inherent in the prior art, it is appropriate for the Examiner to make a

rejection under both the applicable sections of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear evidence that the respective compositions do, in fact, differ as provided for under the guise of *In re Best*, 195 USPQ 430, 433(CCPA 1977); *In re Fitzgerald et al*, 205 USPQ 594.

Even if it turns out that the Examiner has somehow missed the boat and the claims are not anticipated by the prior art *supra* then, it would have been obvious to the skilled artisan to cull, from the disclosure of each of patentees, the invention, as claimed as per such having been within the general disclosures of each of patentees and with a reasonable expectation of success.

Claim Rejections - 35 USC § 103

5. Claims 10 & 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Tatemoto et al*, alone, or further in combination with WO'995 or *Tatemoto et al*.

The disclosure of *Tatemoto et al* is relied upon for the teachings set forth *supra* in paragraph 4 as applied to claims 9 and 13. Further, the disclosure of *Takemoto et al* differs basically from the claimed invention as per the non-specific disclosure directed to O-rings as the molded article resulting from the process of *Takemoto et al*. However, the articles of *Takemoto et al* are generic to and necessarily imply that any molded article, including the specifically claimed O-rings, would have been operable within the scope of patentees invention and with a reasonable expectation of success. Alternatively, molded articles such as O-rings(seal rings), gaskets etc. are commonly known derivatives of cured fluoroelastomer compositions as evidenced by WO'995 and *Albano et al*(page 1, lines 11-16 of WO'995 and col. 10, claim 14 of *Albano et al*). Therefore, it would have been obvious to the skilled artisan to use the process of *Tatemoto et al* for forming molded articles such as O-rings based on the similarities in the fluoroelastomer compositions of patentees and with a reasonable expectation of success.

As to claim 10, *Tatemoto et al* further teach primary curing at 170 degrees C for 10 minutes under both an atmospheric pressure as well as a pressure of 50 Kg/cm² with little

if any change in resulting properties as a result in the pressure as evidence by Table 1. As the peroxides used are taught to be equivalent to include di-t-butylperoxide, t-butylcumylperoxide and dicumylperoxide, similar curing conditions would have been expected to be operable. As the reference teaches no significant change in properties as a result of different pressures used, it would have been obvious to one having ordinary skill in the art to employ any pressure between atmospheric and 50 Kg/cm² with an expectation of equivalent results.

Claim Rejections - 35 USC § 103

6. Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'995, Tatemoto et al or Albano et al as applied to claims 9, 13 and 14(9 and 13 relative to Tatemoto et al) and further in view of Applicant's Own Admissions.

Applicant admits that the primary curing conditions of conventional rubbers is for example 0.1 to 1 hour in a range between 150 and 190 degrees C at a pressure of 0.1 to 10 Pa(specification, page 5, lines 7-17) which are the curing conditions set forth in the instant claim 10. It would have been obvious to one having ordinary skill in the art to use conventional curing conditions as set forth via Applicant's Own Admissions for the primary curing of the compositions of WO'995, Tatemoto et al or Albano et al.

Response to Arguments

7. Applicant's arguments filed 02/06/04 have been fully considered but they are not persuasive.

Relative to WO'995, Tatemoto et al & Albano et al—The crux of Counsel's arguments appears to hinge on the "secondary" curing of all of the Runs of WO'995, Tatemoto et al and Albano et al.

Counsel is reminded, herein, that a reference is evaluated, as a whole, for what it teaches and is in noway limited to the working Runs and to bits and pieces of the

Art Unit: 1713

disclosure. More specifically, the specification need not contain an example if the invention is otherwise disclosed in such manner that one skilled in the art will be able to practice it without an undue amount of experimentation. In re Borkowski, 422 F.2d 904, 908, 164 USPQ 642, 645 (CCPA 1970). Each of WO'995, Tatemoto et al and Albano et al disclose the production of molded articles which have undergone a primary curing step, i.e. the teachings of WO'995, Tatemoto et al and Albano et al are not limited to primary/secondary curing. In any event, even if this is not the case, it would have been obvious to the skilled artisan to conduct primary curing only, with the understanding that the entirety of a reference must be considered as a whole, and with a reasonable expectation of success, absent a clear showing of unexpected results clearly commensurate in scope with the claims. Further, it would have been obvious to the skilled artisan to conduct routine experimentation to determine the conditions under which the fluoroelastomer articles would engender the argued properties. Moreover, claims 13 & 14 do not preclude a secondary curing step as per reasons stated supra. As to the interview request, guidelines for acting on an application are set by the Office and standards governing such include proceeding with prosecution in an expeditious fashion. To this end, an Interview Request is preferably made before the Examiner picks up the case to prepare an Office Action. An apology is extended to applicant for any inconvenience that this may have caused. Counsel is encouraged to arrange an Interview in the future by contacting the Examiner at the phone no. given below.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..

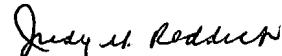
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.


Application/Control Number: 09/403,224

Page 8

Art Unit: 1713

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
02.23.04